

### **Remarks**

Claims 1, 2, 4-12, 24, and 25 are pending in this application. No claims have been amended, but a listing of the claims is provided for the Examiner's convenience.

### **Rejections Under 35 U.S.C. § 102(b)**

#### **Marco**

Claims 1, 2, 4-6, 8, 12, 24, and 25 continue to be rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,899,096 ("Marco"). The Examiner asserts that "blow molding of the neck by Marco inherently results in radial expansion when the material of the neck is forced into the thread formations of the ring." Applicant respectfully traverses this rejection in light of the following amendments and remarks.

The Federal Circuit explained the standard for determining inherency:

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

*Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268-69, (Fed. Cir. 1991) (quoting *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981).

In the previous response, Applicants had amended the claims to recite radially expanding an inner diameter of at least a portion of the neck. In repeating the rejections, the Examiner has not acknowledged this limitation anywhere in the present Office Action.

Applicants had previously described how Marco fails to disclose expanding an inner diameter of any portion of the neck. In Marco, securement of the ring member 18 results from reshaping of the smooth neck portion 14a of preform 10a (FIGs. 1 and 2). The inner diameter of ring member 18 contains annular thread recesses 21. Upon blow molding the preform, the "material of the neck portion 14a will be forced outwardly into locking engagement with recesses 21" of the ring 18, as at portion 15. (*Id.* at col. 2, ll. 34-38.) Alternatively stated, the smooth outer neck portion forms ribs in locking engagement with annular recesses 21. (*Id.* at col. 2, ll. 34-38.) There is no description of radial expansion of any portion of the inner diameter of the neck.

Applicant respectfully submits that Marco fails to disclose expanding an inner diameter of a neck as claimed. One of ordinary skill in the art would understand Marco teaches securing a ring member through two portions of the container: (1) material of the neck is forced outward, forming features 15 of the neck as it is re-shaped against the ring acting as a mold surface, where features 15 engage recesses 21 of the ring, and (2) the ring is also trapped between domed portion 12 of the body and flange 16 on the topmost part of the container neck. Marco does not teach expanding an inner diameter so as to radially expand said neck portion into engagement with an inside diameter of the ring, as recited in claim 1. The engagement in Marco is not due to a radially expanded diameter, but rather to a reshaping of the smooth outer neck of the perform. Marco also does not describe, as recited in claim 24, a portion of the neck having at least one external engagement element, which (pre-existing) external engagement feature engages the ring upon expansion of the inner diameter of the neck. Instead, Marco describes a neck 14a having no engagement element prior to the blow molding. Only upon contacting the ring 18 does material expand at portions 15 to fill recesses in the ring.

The Examiner's rejection relies on a possibility that the inner diameter of Marco's preform neck may expand. To support an anticipation rejection based on inherency, one must provide factual and technical grounds establishing that the inherent feature *necessarily* flows from the teachings of the prior art. See *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); see also *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one). At best, Marco discloses molding outer portions of the neck to fill a recess in an inner portion of the ring. Nowhere does Marco teach expansion of an inner diameter of at least a portion of the neck, as recited in the amended claims. The Examiner has not provided the factual basis to support an inherency rejection showing that Marco's preform necessarily results in at least a portion of the neck has a radially expanded inner diameter upon blow molding.

Accordingly, Applicant respectfully requests withdrawal of this rejection.

## **Suzuki**

Claims 1, 2, 4-6, 8, 12, 24, and 25 are rejected under 35 U.S.C. § 102(b) as being anticipated by JP 52-1-3283 ("Suzuki"). Again, the Examiner relies on the inherency of Suzuki's disclosure to achieve radial expansion of an inner diameter of at least a portion of the neck. Applicant respectfully traverses this rejection.

Suzuki fails to disclose expanding an inner diameter of the neck as claimed. Suzuki provides a bottle main body 1 having a neck part 1b. A threading member 2 is fixed onto the neck part 1b via vertical grooves 2b cut on the inner circumference of threading member 2 (Figure 40). Vertical lines 1b' on the outer circumferential surface of neck part 1b fit perfectly with vertical grooves upon mounting the threading member 2 on neck part 1b. Alternatively, depressions 2c (Figure 5) can be formed on the inner circumferential surface of threading member 2. Upon biaxial molding, the neck part 1b is drawn and molded in the radial direction to fill the cavity in the depression 2c (Figure 6). In a third embodiment (Figure 7), the bottom margin 2d of threading member 2 has the form of a wave with upwards and downwards undulations. Upon biaxial draw molding, neck part 1b is molded with bottom end margin 2d.

However, nowhere in Suzuki is there a disclosure of expanding an inner diameter of a neck to secure the container attachment to a neck. Suzuki's method can affix the neck part 1b to the threading member 2 without radial expansion of the neck. Like Marco, Suzuki at best discloses molding a portion of the outer circumference of the neck to fill cavities (depression 2c) in threading member, and Suzuki does not disclose that expansion of the inner diameter of a neck is necessary to fill the cavities.

Applicants respectfully submit that the Examiner has not provided the sufficient factual basis to establish inherency in view of Suzuki. Accordingly, Applicant respectfully requests withdrawal of this rejection.

## **Rejections Under 35 U.S.C. § 103**

### **Marco or Suzuki in view of Taylor**

Claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over Marco or Suzuki and further in view of U.S. Patent No. 2,944,704 ("Taylor"). Applicant

respectfully traverses this rejection.

Applicants respectfully note that the Examiner has not responded to any of the Applicants arguments regarding Taylor. Instead, the Examiner simply reiterates the previous rejection without indicating how the combination of Marco or Suzuki in view of Taylor would teach or suggest radially expanding an inner diameter of at least a portion of the neck.

The disclosure of Marco or Suzuki does not render obvious the claimed invention. Marco or Suzuki, at best, discloses using outer portions of the neck to fill recesses or containers in an inner portion of a ring. In contrast, the claims recite securing an attachment by expanding an inner diameter of the neck. One of ordinary skill in the art would readily appreciate that the claimed securement would achieve a stronger attachment than the securement achieved by simply molding small portions of the outer circumference of the neck to fill depressions in the inner diameter of the threaded member. Since Marco or Suzuki fail to teach or suggest the claimed method, neither Marco nor Suzuki would render obvious the claimed invention.

Taylor is directed to a dispensing device that contains two fluent or pastelike materials, e.g., a striped tooth paste product. (*Taylor* at col. 1, ll. 29-31 and 40-41.) The device is a collapsible tube dispensing container 10 with a sloping forward end 11 terminating in a nozzle 12. (*Id.* at col. 2, ll. 9-11.) Nozzle 12 has a plurality of threads 13 formed about the outer end for securing a cap. (*Id.* at col. 2, ll. 11-13) A shoulder 22 extends circumferentially around the inner end of nozzle 12 and has a plurality of knurls 23 along the outer periphery thereof, to form a good gripping surface for a connection with the sloping end 11 of container 10. (*Id.* at col. 2, ll. 56-60.)

As discussed above, neither Marco nor Suzuki renders obvious the claimed invention. Taylor does not remedy this deficiency. Unlike the present claims, the nozzle in Taylor is not radially expanded. Taylor merely discloses connecting a nozzle to a sloping end of a container with the aid a plurality of knurls. There is no disclosure that the container is subsequently expanded in any manner, much less by radially expanding the inner diameter of the neck. Thus, there is no teaching or suggestion in Taylor that expanding the inner diameter of a neck would be useful in securing an

attachment to the neck.

Because the Examiner has failed to provide any teaching or suggestion to achieve the claimed invention, a *prima facie* case of obviousness has not been established. Accordingly, Applicant respectfully requests withdrawal of this rejection.

**Marco or Suzuki in view of Yoshino**

Claims 9-11 are rejected under 35 U.S.C. § 103 as being unpatentable over Marco or Suzuki in view of U.S. Patent No. 4,386,046 (“Yoshino”). Applicant respectfully traverses this rejection.

The disclosure of Marco or Suzuki does not render obvious the claimed invention. Marco or Suzuki, at best, discloses using outer portions of the neck to fill recesses or containers in an inner portion of a ring. Yoshino fails to remedy this deficiency as Yoshino fails to even disclose telescoping a ring over a neck of a container. Instead, Yoshino features threads formed directly on the neck of the preform (e.g., FIG. 11) or the neck of the container (e.g., FIGs. 6 and 7 and col. 4, ll. 30-32). One of ordinary skill in the art would have no motivation to telescope a ring over a neck in view of Yoshino.

Moreover, one of ordinary skill in the art would not combine Marco or Suzuki with Yoshino. Whereas Marco or Suzuki in view of Yoshino provide threads via a ring member or threaded member, Yoshino’s preform features threads formed directly on the neck. Thus, the methods of Marco and Suzuki directly contrast that of Yoshino. One of ordinary skill in the art would not see any reason to combine teachings of methods that have no relationship to each other, nor can be applied to the other.

Because the Examiner has failed to provide a *prima facie* case of obviousness with Marco or Suzuki in view of Yoshino, Applicant respectfully requests withdrawal of this rejection.

### **Reconsideration**

It is believed that all claims of the present application are now in condition for allowance.

Reconsideration of this application is respectfully requested. If the Examiner believes that a teleconference would expedite prosecution of the present application the Examiner is invited to call the Applicant's undersigned attorney at the Examiner's earliest convenience.

Any amendments or cancellation or submissions with respect to the claims herein is made without prejudice and is not an admission that said canceled or amended or otherwise affected subject matter is not patentable. Applicant reserves the right to pursue canceled or amended subject matter in one or more continuation, divisional or continuation-in-part applications.

To the extent that Applicant has not addressed one or more assertions of the Examiner because the foregoing response is sufficient, this is not an admission by Applicant as to the accuracy of such assertions.

Please grant any extensions of time required to enter this response and charge any fees in addition to fees submitted herewith that may be required to enter/allow this response and any accompanying papers to our deposit account 02-3038 and credit any overpayments thereto.

Respectfully submitted,

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